

REMARKS

The examiner is thanked for the Office Action dated July 1, 2005. This amendment and request for reconsideration is intended to be fully responsive to the Office Action.

In the Office Action, Claims 1, 2, 3, 14 and 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,273,402 to *Maury* in view of U.S. Patent No. 4,625,937 to *Haase*, and further in view of U.S. Patent No. 4,549,366 to *Gerding et al.* Claim 11 was rejected under 35 U.S.C. 103(a) over *Maury* in view of *Haase* and *Gerding et al.* and further in view of U.S. Patent No. 5,475,386. Claims 4-10 and 13 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Maury* in view of *Haase* and *Gerding et al.*, and further in view of U.S. Patent No. 6,560,794 to *Allen*. Claim 12 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Maury* in view of *Haase* and *Gerding et al.*, and further in view of U.S. Patent No. 3,519,234 to *Matson*. Claims 21-25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Maury* in view of *Gerding et al.*

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior references, when combined, must teach or suggest all of the limitations. MPEP § 2142.

The Federal Circuit has stressed that “[o]ur case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is a vigorous application of requirements for a showing of the teaching or motivation to combine prior art references.” *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999) (emphasis added).

“Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence’”. *Id.*

In the present matter, the Examiner has failed to point to specific information in any of the cited references or in the knowledge generally available to one of ordinary skill in the art which would suggest the combination between the cited references in the manner suggested by the Examiner. Instead, the Examiner only broadly concludes that it would have been obvious to modify the references to teach the claims of the present invention. However, broad conclusory statements regarding the teachings of cited references does not constitute “evidence” for establishing a *prima facie* case of obviousness.

In fact, the only reason provided by the Examiner for the combination is for the purpose of providing adequate vertical and lateral stability, minimal weight, and maximum area for locating boxes of product. This “purpose” comes verbatim from the present application. It appears that the Examiner has used the instant application as a guide for modifying the prior art. However, it is well established that the use of the application under examination as a guide for modifying the prior art constitutes impermissible hindsight, and may not be used in rejection of the claims. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness.

Not only has the Examiner failed to point out specific information regarding the motivation to combine the references in the manner suggested by the Examiner, it is apparent from a close reading of the references that there is absolutely no disclosure or motivation in any of the references to teach or suggest their combination.

For instance, the Examiner notes that *Maury* discloses all of the limitations of the claimed invention except for the segments being first, second and third segments, yet then concedes that

Maury does not disclose a base plate and a horizontal base. The Examiner seeks to rely on *Gerding et al.* for disclosing this feature. However, *Gerding et al.* relates to an adjustable needlepoint stand. It is designed to support a light weight needle work hoop or the like. Because the needlepoint stand of *Gerding et al.* is completely unrelated to the product display stand of the present invention, its combination with *Maury* is improper.

Moreover, the Examiner has failed to provide evidence as to why one having ordinary skill in the art would substitute the respective stands, other than for the purpose recited above. However, the Examiner has provided no evidence that the resulting product would provide vertical and lateral stability, minimal weight, and maximum area for locating boxes of product. In fact, *Gerding et al.* makes absolutely no mention of locating boxes of product on the stand. The stand of *Gerding et al.* is not designed nor suited for that purpose.

Moreover, the base disclosed by *Gerding et al.* does not include the subject matter claimed in independent Claim 1. In particular, the Examiner concedes that none of the references disclose a T-shaped outline. The Examiner argues that this is an obvious matter of design choice. With regard to the examiner's design choice rejection, as indicated above, the Applicant clearly shows the importance of the T-shaped outline. As stated on page 5 in line 11 of the specification, the T-shaped outline formed by the horizontal base support members 28, 30, 32 provides the stand 1 with lateral and longitudinal stability. As further indicated on page 6, lines 2-3 of the current specification, the T-shaped outline of the horizontal base 6 is preferred because it provides adequate vertical stability, minimal weight, and maximum area for locating boxes of the product, as shown in Figures 1, 2, and 4. To sustain a design choice rejection there must be no substantial advantage realized from the use of the claimed subject matter over the structure of the prior art (*See In re Dembiczak*, 50 USPQ 2d 1614 (Fed. Cir. 1999)). Here, as

indicated above, the tubular T-shaped design of the Applicant's horizontal base provides a stand with adequate vertical stability, minimal weight, and provides a maximum area for locating boxes of the product. In contrast, the Examiner has failed to provide evidence that the "H"-shaped stand of *Gerding et al.* is suited for the purpose of supporting product. In fact, *Gerding et al.* is deplete of any reference to supporting product at its base. Accordingly, the combination of *Maury* and *Gerding et al.* is improper.

The other reference relied upon by the Examiner is *Haase*. *Haase* relates to a lantern stand, and has nothing to do with a product display stand of the present application. Moreover, the Examiner has failed to provide a valid reason why one having ordinary skill in the art would replace the pole disclosed in *Maury* with the pole assembly of the lantern stand of *Haase*. There is simply no motivation to combine these references in the manner suggested by the Examiner.

As indicated in MPEP 2143.01, the prior art must suggest a motivation to combine the cited references. It is impermissible to reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching, or motivation to do so. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051-52, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1999). Even if the references actually taught the subject matter of the invention (and in this case they do not), without a motivation taught by the prior art to combine the references, a *prima facie* case of obviousness is improper. The lack of motivation to combine *Maury*, *Haase*, and *Deshler* indicates that the examiner is using impermissible hindsight to construct the Applicant's invention. As stated in MPEP 2141.01, the references must be viewed without benefit of impermissible hindsight afforded by the claimed invention.

It is respectfully submitted that independent Claim 1 is in condition for allowance. Since Claims 2-14 and 19 are dependent on independent Claim 1, it is submitted that Claims 1-14 and 19 are also in condition for allowance.

With regard to independent Claim 21, this claim recites an extended portion of the horizontal base projecting into the T-shaped outline. The Examiner has failed to state where in any of the above-cited references this is disclosed, and merely relies on the rejection of the other pending claims. Moreover, this feature provides further stability to the stand as well as providing additional support for the product placed on the stand. See page 5, lines 15-18 of the present application. It would be impermissible double inclusion to suggest that the elements that form the T-shaped outline also extend into the T-shaped outline. As indicated in MPEP 2143.03, to establish a prima facie obviousness, all claimed limitations must be taught or shown in the prior art.

It is respectfully submitted that independent Claim 21 is in condition for allowance. Since Claims 22-25 are dependent on independent Claim 21, it is submitted that Claims 21-25 are also in condition for allowance.

If the examiner believes that a personal discussion of the application would advance prosecution, the examiner is encouraged to contact applicant's attorney at the phone number listed below. It is believed that no additional charges are due for this submission. However, if this is incorrect, please debit Account 50-0548 and contact the undersigned.

Respectfully submitted,



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Dated: 9/21/05

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